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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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| 09/320,247      | 09/26/99    | ULRICH               | R 001500 500        |

021839 LM02/021Z  
BURNS DOANE SWECKER & MATHIS  
P O BOX 1404  
ALEXANDRIA VA 22313-1404

EXAMINER  
NGUYEN, P

ART UNIT PAPER NUMBER  
2772

DATE MAILED:

3 02/17/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/320,947

Applicant(s)  
ULRICH et al.

Examiner  
Phu K. Nguyen

Group Art Unit  
2772



☒ Responsive to communication(s) filed on May 26, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three (3) month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 15-29 is/are pending in the application.

Of the above, claim(s) none is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 15-29 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

*Phu K. Nguyen*  
PHU K. NGUYEN  
PRIMARY EXAMINER  
GROUP 2400

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 2772

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 15-29 are rejected under the judicially created doctrine of double patenting over claims 1-5 of U. S. Patent No. 5,963,206 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: sets of objects can be grouped into themes to provide a user with the dynamically switchable themes.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

2. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Art Unit: 2772

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 15-29 are rejected under 35 USC 103(a) as being unpatentable over Shrader et al. (5,900,874).

As per claim 15, Shrader teaches the claimed "computer readable medium" comprising:

"A first portion" (Shrader, DroppedIcon, figure 5);

"A second portion" (Shrader, Transformed DrppedIcon, figure 5); and

"A third portion" (Shrader, attributes, figures 6a-6b).

It is noted that Shrader does not explicitly teach the "themes" of the first and second sets of objects as claimed. However, Shrader's assignment of different functions to the DroppedIcons and transformed DroppedIcons suggests the "themes" of the objects as claimed. Thus, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to configure Shrader's computer readable medium as claimed.

Claims 16-18 add into claim 15 the details of data related to the objects which Shrader suggests in the attributes of the DroppedIcon.

Due to the similarity of claims 19-29 to claims 15-18, they are rejected under a similar reason.


Art Unit: 2772

Accordingly, the claimed invention as represented in the claims does not represent a patentable distinction over the art of record.

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phu Nguyen, whose telephone number is (703)305-9796 and can normally be reached Monday-Friday from 8:30 AM to 5 PM.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the group receptionist whose telephone number is (703)-305-3900.

NGUYEN

  
PHU K. NGUYEN  
PRIMARY EXAMINER  
GROUP 2400